

### **REMARKS**

Claims 1, 3-4, 10-11, and 14 have been amended. New claims 17-20 have been added. No new matter has been introduced. After entry of the present amendments, claims 1-20 remain pending in the present application for examination.

#### **§ 103 Rejections**

Claims 1-16 have been rejected under 35 U.S.C. § 103(a) as being allegedly anticipated over Seelig et al. (U.S. 6,758,473 B2) ("Seelig") in view of Driscoll et al. (U.S. 6,496,235) ("Driscoll"). Seelig was filed on September 16, 2002, and Applicants do not concede that Seelig qualifies as prior art under Sections 102 or 103, and reserve their right to swear behind it at a later date.

Seelig discloses a gaming device having a physical indicator 44 that is moved automatically by a drive mechanism to indicate a bonus prize or to indicate a player's progress in achieving a top prize. Seelig does not disclose or suggest that the indicator 44 can be anything other than a physical, 3-dimensional structure that is used as a pointer. In FIG. 1, the indicator 44 resembles a tiki, but the indicator 44 itself was not deemed by Seelig to be important. Seelig mentions that the "number, shapes, designs, and placements of indicator 44 may vary." Seelig, col. 6, ll. 10-12. Indeed, Seelig explicitly mentions a prior bonus game having a bonus selector in the form of a mechanical, movable pointer, disclosed in U.S. Patent No. 6,336,863. Seelig, col. 1, ll. 48-49.

Driscoll discloses an electronic game device (not a gaming machine) that has a small black-and-white LCD that is manually movable by the player relative to a colored background or playing surface to allow different colored background graphics to be viewed through the transparent parts of the LCD display (i.e., in the areas where the individual pixels are turned off, rendering that area transparent). Driscoll explicitly disparaged the use of a motor to move the LCD relative to the background as being too expensive for the hand held LCD market: "LCD products that have a mechanism for scrolling the background image behind a non-moving LCD are either (1) too expensive for the hand held LCD market (if it uses a motor to control the scrolling), or (2) too difficult to maneuver (if it does not incorporate a motor but is instead hand-cranked." Driscoll, col. 2, ll. 17-22. Driscoll emphasizes that the alleged invention is in

allowing “for the *physical sliding or movement* of the LCD over a game playing surface. The *physical movement* enhances game play by making the movements of the LCD part of the skill needed to play the game.” Driscoll, col. 2, ll. 22-26. This aspect of Driscoll is intended to enhance game play by “either forcing a player to move [manually] the LCD to accomplish goals or by introducing new themes to the game player.” Driscoll, col. 2, ll. 44-49.

Applicants traverse the rejections of claims 1-16 on the ground that the Examiner has not met his burden of establishing *prima facie* obviousness. The Office Action concedes, and Applicants agree, that neither Seelig nor Driscoll discloses:

- a drive mechanism connected to a flat panel display;
- a central processing unit having a memory for storing a plurality of video images, the central processing unit further for selecting one of the plurality of video images and communicating the selected video image to the flat panel display for display of the selected video image; and
- the central processing unit further for controlling the drive mechanism to position the flat panel display.

As to each missing claim element, the Office Action asserts that:

- it would have been obvious to modify Seelig with an LCD attached to the drive mechanism to create a more visually appealing gaming machine by introducing new themes to the player and entice the player to play the game initially and longer which produces profit for the gaming establishment;
- it would have been obvious to modify Seelig with an LCD controlling CPU as taught by Driscoll because it is desirable for gaming to enhance the stimulation and excitement experienced by players by introducing new themes to the game players and in turn, have the player play the game and produce profit for the gaming establishment as well as storing and displaying a plurality of images to the LCD;
- it would have been obvious to have one controller operate both the LCD and the drive mechanism to simplify the apparatus and reduce costs.

First, Driscoll explicitly *disparages and discourages* the use of a drive mechanism to control the small black-and-white LCD display, and therefore Driscoll **teaches away** from Applicants’ claimed invention. Such “teaching away” constitutes potent evidence of nonobviousness of the combination. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301, 198

USPQ 344 (CCPA 1978). Instead, Driscoll provides for a **manually controlled** LCD slider that is pushed along a pathway using a knob or the like. Driscoll, col. 3, ll. 42-45. The problem specifically addressed by Driscoll's slider system was that "[n]one of the past solutions allow for the **physical** sliding or movement of the LCD over a game playing surface." Driscoll, col. 2, ll. 22-24. Thus, after disparaging the use of drive mechanisms for automatically moving an LCD relative to a background, Driscoll announces his solution as providing for the **physical** sliding of an LCD over a game playing surface in a portable, handheld game playing device. Therefore, one of ordinary skill in the art would have found no inspiration whatsoever in Driscoll to connect Driscoll's LCD to a CPU-controlled drive mechanism, but instead would have found an explicit teaching away from such an arrangement.

Moreover, Driscoll does not relate to wagering games, and the independent claims have been amended to call for receiving a wager to play a wagering game on the gaming machine, a limitation not disclosed in Driscoll. One of ordinary skill in the relevant art at the time of Applicants' invention would not have been motivated to consult a reference that relates to a handheld, portable game device utilizing a small black-and-white LCD display that is manually moved by hand over a game playing surface.

Second, Seelig never even suggests the desirability of modifying the physical, three-dimensional indicator object to anything other than a different physical, three-dimensional indicator object. Tellingly, with respect to other structures on the bonus display 12 besides the indicator 44, Seelig does disclose that a video-type display can be used. For example, the bonus display 12 includes a meter 33 for displaying a bonus prize to be awarded to a player, and that such meter 33 "may comprise a light emitting diode display." However, notwithstanding this disclosure, Seelig never even suggests modifying the indicator 44 with such an LED display or any other video-type display. Seelig also discloses that the gaming outcome display 21 or bonus reel 29 may be a video display, Seelig, col. 4, ll. 22-29; however, notwithstanding this disclosure, Seelig never mentions or suggests modifying the indicator 44 to be a video display. In short, Seelig is **completely silent** about modifying the indicator 44 to be a flat panel display. The other reference, Driscoll, **teaches away** from attaching an LCD to a CPU-controlled drive mechanism. Therefore, the Examiner has not established a *prima facie* case for obviousness because there is

no suggestion whatsoever in Seelig or Driscoll to modify the indicator 44 of Seelig to be a flat panel display.

The Office Action appears to suggest at page 4 that Seelig's use of the word "animated" to describe the indicator 44 is somehow a suggestion to modify the indicator 44 to an LCD display; however, Applicants point out that the term "animated" as used in Seelig means cartoon-like, as described in more detail in a related Seelig patent, U.S. Patent No. 6,537,152, entitled "Gaming Device Having an Animated Figure." The indicator 44 shown in the drawings of Seelig is a tiki, Seelig, col. 6, ll. 9-10, and has an animated or cartoon-like appearance (FIG. 1). This animated or cartoon-like appearance of the indicator 44 was the only desirous characteristic of the indicator 44 advanced by Seelig. In describing problems with prior gaming devices, Seelig criticized them on the basis that "their indicators are not animated." Seelig, col. 1, l. 65. The indicator in U.S. Patent No. 6,336,863, summarized by Selig, was a mechanical, movable pointer that did not have an animated appearance. Indeed, Seelig nowhere suggests that the indicator 44 can be moved independently of the drive mechanism 50. Rather, the indicator 44 itself remains stationary and fixed and moves with the drive mechanism 50 only.

Without any suggestion of the desirability of the Seelig-Driscoll combination, what remains, then, is an assertion that the references *can* be combined or modified, but this alone is not sufficient. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682 (see also *In re Fritch*, 972 F.2d at 1260 (Fed. Cir. 1992)). The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Regarding the claims that depend from independent claims 1, 10, and 11, they are believed to be patentable for at least the reason that the respective independent claims from

which they depend are patentable. In addition, dependent claims are patentable for at least the following additional reasons.

Regarding claims 3 and 13 as amended, the proposed combination of Seelig and Driscoll does not disclose a CPU determining a randomly selected game outcome that determines the video image selected by the CPU. Seelig does not disclose a video image displayed on a flat panel display ("FPD") that is connected to a CPU-controlled drive mechanism. Driscoll does not disclose a CPU that determines a randomly selected game outcome nor a flat panel display whose selected image is determined by that outcome. Claims 3 and 13 as amended do not support a *prima facie* case for obviousness, and are patentable for at least the reasons given above.

Similarly, claims 4 and 14 as amended are patentable over the Seelig-Driscoll combination because that combination does not disclose a CPU determining a randomly selected game outcome, the randomly selected game outcome determining the position of the FPD, the randomly selected game outcome further for determining the video image displayed on the FPD.

Regarding claim 7, the Examiner concedes that Seelig does not disclose wherein the drive mechanism comprises a first carriage and a second carriage, the first carriage moveable relative to the game display, the second carriage moveable relative to the first carriage, the flat panel display connected to the second carriage, each carriage having a motor for positioning the flat panel display. However, the Examiner concludes, without citing to any teachings in the prior art or to any knowledge of persons of ordinary skill in the art that it would have been obvious to provide such a claimed drive mechanism. Applicants traverse such a bald conclusion, supported by nothing in the record, as a basis for rejecting claim 7. The Examiner must show reasons why a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Moreover, the showing must be clear and particular. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For reasons unrelated to the claim rejections, Applicants have amended the independent claims to call for positioning or moving the flat panel display along a translational path.

New claims 17 and 19 recite wherein the selected video image includes an image indicative of a randomly selected game outcome associated with the wagering game. New claims

18 and 20 depend from claims 17 and 19, respectively. Neither Seelig nor Driscoll nor the combination thereof discloses the selected video image including an image indicative of a randomly selected game outcome associated with the wagering game. For at least this additional reason, new claims 17-20 are believed to be patentable over the cited references.

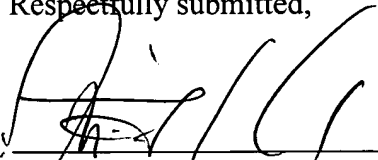
### **Conclusion**

It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

A check in the amount of \$120.00 is enclosed for the extension of time fee. It is believed that no other fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00221USPT.

Date: August 4, 2006

Respectfully submitted,



Justin Swindells

Reg. No. 48,733

JENKENS & GILCHRIST, P.C.

225 West Washington Street, Suite 2600

Chicago, Illinois 60606-3418

(312) 425-3900 - Telephone

ATTORNEY FOR APPLICANTS